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From: Kramer, Bruce E.

Sent: Monday, June 06, 2005 7:00 PM

To: AB85 Comments

Subject: Comments on Proposed Rule Changes regarding Translations of Foreign Language Provisional Applications

Dear Ms. Ferriter:

Please consider the following comments on the proposed rule changes regarding translations of foreign language provisional applications set forth in the Federal Register on April 7, 2005 (Volume 70, Number 66). As background, I file a number of provisional applications in a foreign language. While I file a translation of the provisional application in the provisional application most of the time, sometimes I file the translation in the non-provisional application claiming benefit of the provisional application. For example, for business reasons, my client may not be able to decide whether to file a non-provisional application claiming the benefit of the provisional application until almost one year after the provisional application was filed, so the translation cannot be prepared in time for filing in the provisional, and we end up filing it in the non-provisional.

(1) To the extent that there is a problem that examiners, applicants, and the public are confusing a provisional translation with the application to be examined when the translation is not filed in the provisional, it seems to me that this problem could be solved simply by having the provisional translation filed in the application to be examined after the application to be examined has already been filed. The subsequent filing of the provisional translation could then be clearly labeled as such, and no confusion should result. This would provide the significant benefits of avoiding the time pressure and translation cost where, for business reasons, an applicant cannot decide whether to file a non-provisional application until almost one year after the provisional application was filed and ultimately decides not to file a non-provisional application (under the proposed rule, an applicant would need to obtain a translation of the provisional to preserve the option of filing a non-provisional). In this regard, please note that the translation cost would almost certainly be substantially higher than the cost for filing copies of the provisional translation in continuing applications. As to the burden on the public in finding the translation and statement, it would not seem to be so great - if the translation and statement are not in the provisional, one would just go on to look in the non-provisional. As to the burden on the Office in storing possibly duplicate copies, it's my understanding that the translation would now simply be scanned in, so the burden on the Office would not seem to be so great either.

(2) As an alternative, I don't know if it would be possible to file a translation of the provisional in the provisional more than one year after the provisional was filed (i.e., after the provisional has been abandoned), but if it would be possible, such could (i) solve the problem of confusion, (ii) provide the present benefit of allowing an applicant to make a business decision regarding the filing of a non-provisional close to the one year date after the filing of the provisional without the need for a translation to be prepared beforehand, (iii) avoid the cost of filing copies of the provisional translation in continuing applications, (iv) solve any problem of the public trying to find the translation, and (v) solve any problem of the Office having a storage burden.

(3) In the event that the proposed rule goes forward requiring that the provisional translation be filed in the provisional, and assuming that it is not possible to file the provisional translation in the provisional more than one year after the filing date of the provisional (i.e., after the provisional has been abandoned), I think that where an applicant has already relied on the present rule which permits a provisional translation to be filed in the non-provisional, it would be unfair not to permit the applicant in such a case to file the provisional translation in the non-provisional. That is, the

proposed rule should only apply where the foreign language provisional application itself was filed on or after the effective date of the rule.

I think that the present rule works very well, and that the advantages of changing to the proposed rule are not so great as to outweigh the benefits of the present rule which will be lost. However, if the rule is to be changed, I would appreciate your consideration of my comments. Thank you.

Respectfully submitted,

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